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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,838	03/22/2001	Robert Icho	4168	6410
7590	05/23/2005		EXAMINER	
Harris Zimmerman Law Offices of Harris Zimmerman 1330 Broadway, Suite 710 Oakland, CA 94612-2506			JANVIER, JEAN D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/815,838	ICHO, ROBERT	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jean Janvier	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3 and 7-14 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 and 7-14 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

### **Response To Applicant's Arguments**

First, although the Applicant is correct that claim 13 was inadvertently left out in the prior Office Action, however, the claim limitations recited therein are similar in nature to rejected claim 1 and the current substantial amendments to the claim including converting it to an independent claim have now rendered these arguments null and void. Second, the rest of the arguments are very broad in nature. Further, it appears here that the Applicant relies heavily on limitations from the specification to support his position. However, the Examiner does not read limitations from the specification into the claimed invention.

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the current **Office Action has been made Final.**

### **DETAILED ACTION**

#### *Specification*

#### **Status of the claims**

Claims 4-6 are canceled and claims 1-3 and 7-14 are now pending in the Instant Application.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3 and 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda et al. (hereinafter Ikeda), US Patent 5,937, 391.

As per claims 1, 2, 3, 9-11, 12, 13 and 14, Ikeda discloses a point-service system (incentive reward program) for issuing points to a customer for purchases made at various stores

or shops within an online shopping mall (first reward program) comprising a points issuing unit 1 of fig. 1 for issuing points based on purchase amounts of the customer or participant (col. 3: 52-53), a points management unit 2 of fig. 2 for storing the points (total points or base points) accumulated by the customer and a points redeeming unit 3 of fig. 1 for reducing a purchase amount of the customer upon redeeming points at any participating store within the mall. This system shortens the time from issuing points to redeeming points. In one embodiment, Ikeda discloses a service system wherein a specific customer makes a request to buy goods (participant's action) from a **home page or web site** of an online shopping mall and in response to this request, the service system causes the number of effective points (base points) accumulated by the customer and issued by a plurality of shops for each purchase made at each respective shop to be displayed on the customer's terminal or participant's unit, subsequent to identifying the customer or participant using the customer's or participant's ID, by referring to the data of each shop forming part of the online shopping mall. **If the customer still decides to order a product (participant's action), he can click on a shopping button associated with one of the displayed shops to subsequently access an order button or a particular shop server or web site and hence, the point-service system or service system linked to a web server of the online shopping mall is activated to issue points or redeem points at the customer's request or instructions when he inputs an order** (displaying a plurality of vendors on the program or shopping mall web site) (see abstract; col. 2: 10-67; figs. 1-19). It is to be understood that a customer can explicitly or implicitly make a request from the point-service system to buy a product from a participating shop, redeem points or simply query the point-service system database for the effective points (base points) accumulated to date. It is further to

be recognized that a participating shop or vendor may or may not have its own server or web server or web site. Here, the steps of registering and storing the user's registration information including an e-mail address, reporting purchases made by the user at one or more shops or vendors for the purpose of providing points or credits to the user based on the purchases amounts and reiterating or repeating the process of reporting or tracking the user's purchases and crediting the user's account are implicitly or explicitly supported by Ikeda (col. 4: 41-60; col. 5: 22-38; col. 4: 34-40; col. 10: 55 to col. 11: 3). **Additionally, the user or customer can access the online shopping mall or web site to check his or her number of accumulated and stored points and purchase history or information on the user's points stored under his account in a database can be periodically e-mailed to the user by a shopping mall or program web site administrator or manager, who also has an e-mail address** (or the process of e-mailing the customer may be carried out automatically using the manager's or program web site e-mail address) (col. 4: 34-38).

Moreover, the points issuing unit issues points based on the purchase amount of a customer or participant at an online shopping mall. The point issuing unit issues points based upon, for example, input information such as the name of the shop and the purchase amount and the points issue ratio set for each shop. For example, the points issue ratio is indicative of how many points are issued when a customer or participant spends 100 Yen at a shop (1 point for every 100 Yen spent). The points issue ratio can also be set to a value larger than a normal value in a special campaign period such as an end-of-year sales period (col. 2: 28-37).

In addition, a points redeeming ratio performs a points redeeming process by reducing the purchase amount for a particular customer or participant during a transaction at a specific shop,

based on the number of total points (base points or effective points) accumulated thus far throughout the system or at that shop, wherein the customer or participant chooses to redeem some of his points (base points) at the specific shop and wherein each participating shop has a different points redeeming ratio. For example, shop A of fig. 9 reduces during a certain period of time the customer's purchase by 1 Yen for every 1 point redeemed, hence a 1:1 ratio or redemption rate. Like the points issue ratio, the points redeeming ratio or redemption rate for a specific period, such as an end-of-year sales campaign, can be set to a value higher than a normal period (increasing or adjusting or providing a higher redemption points ratio or redemption rate to the customer if the customer performs an action such as purchasing products at a shop participating in the end-of-year sales campaign). (col. 2: 38-64: col. 3: 62-67; col. 8: 1-23; col. 9: 55 to col. 10: 2). In other words, each specific shop issues points to a customer or redeems the customer's effective points (base points) during a purchase transaction in accordance with the points issue ratio and points redemption ratio set for each specific shop during a specific period of time (**the shop or vendor issues or redeems points in accordance with its own prescribed points issuing and redeeming rates or ratios independent of the default ratios set by the program web site or shopping mall point service system**).

Finally, the steps of reporting a user's transaction data associated with a purchase or a redemption back to the shopping mall service system or program web site (especially if the shop or vendor uses its own server) for the purpose of providing points to the user for the purchase, for reconciling points after a redemption (especially when points issued from shop A are redeemed during a transaction at shop B and the redemption rate is unique) and for overall system management are implicitly supported by Ikeda. Further, it is silently disclosed that the

points must be acquired from a points provider, as practiced in the art, such that, for example, a shop or vendor may have to acquire or purchase the points from the shopping mall service manager, especially if the shop distributes the points directly to the user (the shop may have to compensate the shopping mall manager for providing points to the registered users on behalf of the shop).

As per claims 1, 7, 8 and 13, although a points service system wherein a registered user conducts a purchase at a participating shop or vendor, which provides points or incentives to purchasers or registered users, and the transaction data related to the purchase are transmitted in real-time to the points issuing component of the system for rewarding or issuing points to the registered user based on the amount of the purchase, however, Ikeda does not explicitly disclose the steps of using by a registered user the e-mail address of the system manager or program web site during a transaction at a shop's or a vendor's web site, reporting **by the shop** the user's purchase transaction via e-mail to the program web site or shopping mall system using the program web site e-mail address received from the user during the purchase, confirming the user's purchase with the shop via e-mail and sending by the program web site an e-mail confirmation to the registered user.

However, using an e-mail as a communication means between two or more parties in a variety of ways is well established and well taught in the art. For example, a user who registers for a scheduled event via a web site associated with the scheduled event may receive an e-mail confirmation or reminder from the web site. Furthermore, a user or purchaser who purchases a

product from a web site may receive an e-mail from the site to, for instance, confirm the purchase, notify the user that the ordered item is out stock and will be delivered at a later date and so on and so forth.

It is also customary in the art to tag a user's visit to a referring web site where the user clicks on a product or on a related referral link, having embedded therein an ID uniquely identifying the referring web site or associate's web site, displayed thereon to thereby hyperlink to the product vendor's or advertiser's web site where the featured product is bought, wherein the vendor or advertiser compiles a complete and unique daily or weekly report, depicting the referred customers' or users' activities at the vendor's site, for the referring or associate web site and wherein the (transaction) report is sent to the referring or associate web site via e-mail using an e-mail of the referring web site and wherein the report is used to measure the system effectiveness and to accurately compensate the referring web site for the referrals.

Moreover, transmitting the user's purchase transaction with a participating shop to the shopping mall system or program web site via e-mail, rather than reporting the said purchase transaction in real-time transmission, as taught by Ikeda, from the shop, especially when the shop is using its own server, to thereby is a matter of desires, which does not directly impact how the points or credits are issued and redeemed.

(“Official Notice”)

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure into the Ikeda's point service system so as to have a registered user provide an identifier such as an e-mail address related to the shopping mall

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system manager or program web site, or to transparently extract from the user's local browser the referring web site ID, during a transaction at an associated shop or vendor web site in order to report in substantially real-time the user's purchase transaction via e-mail to the identified program web site or shopping mall system for confirming whether or not the current transaction is eligible to receive credits or points and if the current transaction is eligible to receive points, then the user is notified via e-mail that the transaction has been completed and that a certain number of points has been added to his account as a result of the current transaction, thereby making it possible to identify which program web site or shopping mall system the user conducting the current transaction belongs to or is associated with, especially when the shop or vendor or advertiser's web site where the user is shopping is associated with more than one shopping mall system or program web site and/or the vendor or shop is using its own server to store product data and conduct business transactions (col. 4: 56-60).

### **Conclusion**

Although the following references were not used in the Office Action, they were highly considered by the Examiner. Applicants are further directed to consult these references.

US Patent 5,806,045A to Biorge et al. discloses a method and system for allocating and redeeming incentive credits between a portable device and a base device.

US Patent 6, 142, 371A to Omeda discloses a customer service system having a point value and discount rate.

US Patent 5, 537, 314 to Kanter discloses referral recognition system having a point and discount conversion tables.

US Patent 6,594,640B1 to Postrel discloses a system and method for operating a reward points accumulation and redemption program wherein a user earns reward points from a plurality of independent reward points issuing entities, with each tracking the user's earned reward points in a user reward point account stored on a rewards server (such as a frequent flyer account or a credit card loyalty account). On selective request by the user, a trading server accumulates some or all of the user's earned reward points from the reward servers and credits the accumulated points into a single reward exchange account associated with the user. The user may then select an item for purchase with the accumulated reward points. The item is provided to the user in exchange for a subset or all of the reward points.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719

**05/12/05**

**Jean D. Janvier**

JDJ

Patent Examiner

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**JEAN D. JANVIER**  
**PRIMARY EXAMINER**

*Jeanne Jean Darno*